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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,937	06/21/2001	William Paul Bullock	031-3	4857

7590

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EXAMINER

HELMER, GEORGIA L

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*nc*

## Office Action Summary

Application No.

09/886,937

Applicant(s)

BULLOCK ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Request for Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 June 2005 has been entered.

***Status of the Claims***

1. Applicant has amended claims 1 and 2; claims 1-20 are pending and claims 1-6 are examined in the instant action.
2. All rejections not addressed below have been withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The phrase "for less than 10 seconds" (claim 1) is not supported by the originally filed specification or claims. Applicant is invited to point out the page and line number in the specification where support for these phrases can be found. Absent such support, Applicant is required to cancel the new matter in response to this Office Action.

***Claim Rejections - 35 USC § 102***

6. Claims 1, 4, and 5 remain rejected under 35 U.S.C. 102(b) as being anticipated by Coffee, et. al., US 5,302,523, issued 12 April 1994 (IDS).

Applicant traverses saying primarily (Response, p. 1) that the Examiner has improperly combined the primary reference (Coffee, et. al., US 5,302,523) with a second reference (coleparmer.com/catalogue/0304, 1 February 2005) in the § 102 anticipation rejection. Applicant further traverses that the Examiner, in stating that when the genie vortices is turned on and comes to full speed, is subject to a continuum of frequencies which include both 1000 and 768 cycles per minute, is arguing obviousness and not anticipation. Applicant further sets forth that the Examiner has not shown that either of these cycles per minute can be reached for more than a tiny fraction of a millisecond.

Applicant's traversal is unpersuasive. A 35 USC 102 rejection over multiple references has been held to be proper when the extra references are cited to: (A) Prove the primary reference contains an "enabled disclosure;" (B) Explain the meaning of a

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term used in the primary reference; or (C) Show that a characteristic not disclosed in the reference is inherent. See MPEP § 2131.01. Examples (B) and (C) apply to the present situation. Furthermore, the critical date of extrinsic evidence showing a universal fact need not antedate the filing date. See MPEP § 2124. Applicant's traversal that the Examiner has not shown that either of these cycles per minute can be reached for more than a tiny fraction of a millisecond, is an argument not in accord with the scope of the claims, which are drawn to a time period of "less than 10 seconds".

### ***Claim Rejections - 35 USC § 103***

7. Claims 1- 6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Coffee, et. al., US 5,302,523, issued 12 April 1994 (IDS), as discussed above for claims 1, 4, and 5, in view of the state of the art as evidenced by Cole-Parmer Instrument Company.

Applicant traverses saying primarily that the use of a paint mixer machine to shake the cells+DNA is not an obvious choice at the time of the invention and that scientists were using aggressive mixing machines to do the exact opposite of what the instant invention does, and that if anything, the instant invention was totally counterintuitive. Applicant's traversal is unpersuasive. Applicant is making a conclusionary statement without any evidentiary basis. See also Lindner and Grasselli cited in the last Office Action.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of US application No. 10/341,982. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant case, if allowed, would read on claims 1-6 of US application 10/341,982. The claims are coextensive. This is a provisional double patenting rejection because the conflicting claims in neither case have been allowed.

#### **Remarks**

8. No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0796. The examiner can normally be reached on M-Th, 10:30am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 571-272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Georgia Helmer PhD  
Patent Examiner  
Art Unit 1638 – Transgenic Plants  
25 August 2005

DAVID T. FOX  
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GROUP 180

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